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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
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Signature _____

Typed or printed
name Jennifer Gaines

Application Number
10/759,585

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January 14, 2005

First Named Inventor
Gary Wayne Bagnall

Art Unit
3643

Examiner
Rowan, Kurt C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

No fee is believed due, as the previously paid notice of appeal fee and appeal brief fee should be applied to the new appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Joseph G. Swan/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Joseph G. Swan

Typed or printed name

☒ attorney or agent of record.

Registration number 41,338

310-312-3188

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

April 26, 2006

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appellants' Pre-Appeal Conference Remarks

Claims 1-16 and 18-23 are pending in the application, with claims 1, 2, 7, 10, 13 and 20 being the independent claims. Claims 2 and 13 stand rejected under 35 USC § 102(b) over U.S. Patent 5,274,949 (Beaton); claims 3, 7, 10 and 20-23 stand rejected under § 103(a) over Beaton; and claims 1, 4, 5, 6, 8, 9, 11, 12, 14-16, 18 and 19 stand rejected under § 103(a) over Beaton in view of U.S. Patent 5,363,589 (Flynn).

Generally speaking, the present invention is directed to an apparatus for capturing live insects, such as the apparatus shown in Figures 1-4 of the Specification. With reference to the exemplary embodiment shown in those drawings, an upper section 20 of the apparatus houses a light source 21, and has side walls 24, a top cover 22, and plural openings 26 in the side walls that are large enough to permit insects to enter. The apparatus 10 also includes an enclosed lower section 60 and a funnel and 90 between the upper section 20 and the lower section 60, with the funnel and 90 having a wide opening 93 adjacent to the upper section 20 and tapering to a narrow opening 91 within the lower section 60. Each of the pending independent claims recites a different aspect of the apparatus, in addition to the foregoing general features of the invention.

More specifically, independent claim 2 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. The side walls of the upper section have an inner surface that is reflective.

The foregoing combination of features is not disclosed by the applied art. In particular, Beaton does not disclose at least the feature of an upper section, as recited above, with side walls having an inner surface that is reflective.

With respect to this feature, the Examiner acknowledges that Beaton only discloses an upper section having transparent side walls. However, the Examiner goes on to assert:

"... inherently, the inner surface of the side walls is somewhat reflective in that part of the light incident on the surface is reflected and the rest of the light is transmitted... So even with a transparent surface as disclosed by Beaton, some of the light will be reflected."

Essentially, the Office Action is arguing that the inner surface of Beaton's side walls should be deemed "reflective" because it "inherently" is capable of reflecting some amount of light. By this standard, any actual physical surface could be called "reflective" because every physical surface necessarily reflects some light. In fact that very clearly is the position that is being taken in the Office Action. The assertion of such inherency, without any specific knowledge to support such a position, must only be based on the fact that Beaton's side walls are a physical surface that necessarily reflects some amount of light.

However, if every surface is "reflective", then the term "reflective" has no meaning or limiting effect at all. Such a definition is clearly unreasonable.

In any reasonable usage, surfaces are characterized by their dominant optical characteristics. It would be very strange to hear an ordinary window called "reflective", even though some amount of light necessarily will be reflected off of its surface. Similarly, one would not call a mirror absorptive, even though it certainly will absorb some amount of the light that is incident upon it.

While the inner surfaces of Beaton's side walls certainly must reflect some amount of light, as every physical surface must, there is absolutely no indication in Beaton that such reflection is, or is intended to be, more than *de minimis*. Certainly, there is no indication that Beaton's side wall surfaces should be characterized as "reflective". As acknowledged by the Examiner, Beaton himself only characterizes such surfaces as "transparent" or "clear". See, e.g., column 1 lines 9-10 and 52-53, and column 2 lines 5-6 of Beaton.

Lacking this feature of the invention, claim 2 could not have been anticipated by Beaton. Accordingly, independent claim 2 is believed to be allowable over the applied art.

Independent claim 13 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. A provided cover attaches to the enclosed lower section when the enclosed lower section is removed from the upper section.

The foregoing combination of features is not disclosed by the applied art. In particular, Beaton does not disclose at least the feature of a cover that attaches to the enclosed lower section when the enclosed lower section is removed from the upper section.

Although the Examiner asserts that Beaton's cover 27 attaches to Beaton's lower section, there is no indication in Beaton that this is in fact the case. First, it is noted that claim 13 recites that the lower section is the portion of the apparatus in which the funnel tapers to a narrow opening. This apparently would correspond to Beaton's collection jar 24. Appellant is unable to find anything in Beaton that suggests that Beaton's clear plastic disc 27 is a cover that attaches to Beaton's collection jar 24 when collection jar 24 is removed from the upper section of Beaton's apparatus. In addition, the Examiner has cited no portion of Beaton in support of this assertion.

To the contrary, disc 27 is illustrated in Beaton's Figure 3 as attaching to Beaton's upper section. Apparently acknowledging this fact, the Office Action next argues that "it would have been obvious to provide Beaton with a cover to the enclosed lower section to prevent insects from escaping from the trap, noting it is obvious to rearrange to the parts of Beaton."

In response, it is first noted that the present rejection of claim 13 is under § 102, not § 103, so arguments regarding obviousness are irrelevant. Moreover, nothing at all in Beaton would suggest moving plastic disc 27 from the top of Beaton's upper section to the top of the lower section. To the contrary, it is apparent that disc 27 has a specific purpose, i.e., to allow fluorescent tube 29 to extend into Beaton's upper section. For this purpose, it includes a hole 27'. Thus, even if disc 27 were moved to the top of Beaton's lower section, the presence of hole

27' would have made disc 27 largely ineffective as a cover "to prevent insects from escaping from the trap", as is asserted in the Office Action.

In short, there is no express or implied motivation to make the modification suggested in the Office Action, and any attempt to do so would not have resulted in the benefit asserted in the Office Action. Accordingly, independent claim 13 is believed to be allowable over the applied art.

Claim 3 depends from independent claim 2 and recites the further limitation that the inner surface of the side walls is white. This additional feature of the invention is not disclosed or suggested by the applied art.

As to this limitation, the Examiner acknowledges that Beaton's sleeve 21 is clear. However, the Examiner then asserts, "it would have been obvious to employ a white inner surface of the sleeve since the insects are attracted to light colors." The Examiner provides no support for this assertion. In addition, the Examiner does not point to anything in Beaton that would have suggested the desirability of altering the inner surface of the side walls of Beaton's sleeve 21 in any manner to achieve the goal of attracting insects to them. In short, there would have been no motivation to modify Beaton's apparatus as suggested by the Examiner.

For these additional reasons, dependent claim 3 is believed to be allowable over the applied art.

Independent claim 7 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. The light source is an ultraviolet light source.

The foregoing combination of features is not disclosed or suggested by the applied art. In particular, the Beaton does not disclose or suggest at least the feature of an ultraviolet light source.

With regard to this feature of the invention, the Examiner merely asserts that, "it would have been obvious to employ an old and well known ultraviolet light source for the known insect attracting properties." However, while ultraviolet lights clearly are conventional, there is nothing in the applied art that would have suggested incorporating an ultraviolet light into the apparatus described in Beaton. Without any such motivation to combine prior art features, a prima facie case of obviousness under the provisions of MPEP § 2142 cannot be established.

In the current final rejection, the Examiner asserts, "those skilled in the art know that insects are attracted to the wavelengths produced by an ultraviolet light source." However, nothing in the applied art has been cited in support of this assertion, and certainly nothing has been cited to show that ultraviolet light is more attractive to insects than to other types of light, as a general matter. In fact, if that were the case, then presumably Beaton would have mentioned the use of such a light source in his apparatus. However, in view of the current prior-art

disclosures, nothing would have suggested replacing Beaton's light source with an ultraviolet light source.

Accordingly, independent claim 7 is believed to be allowable over the applied art.

Independent claim 10 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. The upper section has an outer surface that is substantially entirely dark.

The foregoing combination of features is not disclosed or suggested by the applied art. In particular, Beaton does not disclose or suggest at least the feature of an upper section, as recited above, having an outer surface that is substantially entirely dark.

The Examiner apparently acknowledges that Beaton does not disclose this feature of the invention. As noted above, Beaton itself describes its upper section as being clear or a transparent. However, the Examiner asserts, "it would have been obvious to provide a dark color on the outside of the upper section to provide a contrast and the dark color would contrast with the clear of the lower portion and insects would be attracted to this contrast." This asserted motivation is not found anywhere in Beaton (and the Examiner does not even allege that it is), but rather it is merely hindsight based on Appellant's own Specification. Any such arguments are clearly improper in connection with an obviousness rejection.

The Office Action also asserts that, "a transparent sleeve can be colored," but then immediately acknowledges, "Still, Beaton does not disclose a dark color on an outer surface of the upper section." It should be added that Beaton does not even remotely suggest such a feature.

In short, the present rejection is based entirely on assertions of obviousness that are not supported by anything in the prior art. Accordingly, independent claim 10 is believed to be allowable over the applied art.

Independent claim 20 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. The openings cover approximately 30-40% of the total area that would be provided if the side walls were completely closed.

The foregoing combination of features is not disclosed or suggested by the applied art. In particular, Beaton does not disclose or even remotely suggest at least the feature of openings in the side walls of an upper section, as recited above, covering approximately 30-40% of the total area that would be provided if the side walls were completely closed.

The Examiner acknowledges that Beaton does not disclose this feature of the invention and that Beaton appears to show a smaller area enclosed by his openings. However, the Examiner then goes on to assert, "the amount of area enclosed by the openings is a matter of design choice to be determined through routine experimentation since no stated problem is solved." No justification has been provided for such an assertion, and there is absolutely no suggestion in Beaton that one should experiment with the sizes of the openings to obtain better results. Without such a suggestion, there would have been no motivation for one of ordinary skill in the art to engage in such "routine experimentation".

As noted above, the recited amount of openings is believed to provide the greatest efficiency in capturing insects. However, nothing in Beaton would have disclosed or suggested this feature of the invention.

Accordingly, independent claim 20 is believed to be allowable over the applied art.

Independent claim 1 is directed to an apparatus for capturing live insects. An upper section of the apparatus houses a light source, and has side walls, a top cover, and plural openings in the side walls that are large enough to permit insects to enter. The apparatus also includes an enclosed lower section and a funnel between the upper section and the lower section, with the funnel having a wide opening adjacent to the upper section and tapering to a narrow opening within the lower section. A removable funnel insert is disposed within the funnel, restricting the narrow opening of the funnel to a smaller size.

The foregoing combination of features is not disclosed or suggested by the applied art. In particular, no permissible combination of Beaton and Flynn would have disclosed or suggested at least the feature of a removable funnel insert disposed within another funnel, restricting the narrow opening of such other funnel to a smaller size.

With regard to this feature, the Office Action acknowledges that Beaton does not show a removable funnel insert disposed within another funnel. However, in order to make up for this deficiency, the Office Action asserts that Flynn, "shows an insect trap having a funnel 32 and a funnel insert 30 as shown in Fig. 2."

However, Flynn itself describes elements 30 and 32 as different portions of the same passageway 12. See, e.g., column 3 lines 33-38. Nothing in Flynn indicates that upper portion 30 and lower portion 32 are different funnels, or that Flynn's apparatus includes a removable funnel insert disposed within another funnel.

Even the Office Action does not assert that either element 30 or 32 is a "removable funnel", as presently recited. Moreover, as noted above, the Office Action expressly acknowledges that Beaton does not disclose or suggest this feature of the invention.

In this regard, MPEP § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations. Lacking the referenced feature of the present invention, no permissible combination of Beaton and Flynn would have rendered independent claim 1 obvious. Accordingly, independent claim 1, together with its dependent claims 4-6, 8, 9, 11, 12, 14-16, 18 and 19, is believed to be allowable over the applied art.